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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,626	02/25/2004	Feng-Ling Hsu	TSAI 133	2938
7590 11/02/2005 RABIN & BERDO, P.C. Suite 500 1101 14 Street, N.W. Washington, DC 20005			EXAMINER POLLICOFF, STEVEN B	
			ART UNIT 3728	PAPER NUMBER

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/785,626		HSU, FENG-LING	
	Examiner		Art Unit	
	Steven B. Pollicoff		3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 1,4, and 7 are objected to because of the following informalities: The term "inner fixed piece" is inconsistent with 1) the specification, which discloses a lower side plate comprising an "inner side piece" and 2) Claim 13 which uses the term "inner side piece". For clarity and consistency, choose either "inner fixed piece" or "inner side piece", but not both. Appropriate correction is required.

Specification

2. The disclosure is objected to because of the following informalities: The element "outer side piece" is given reference number 260 (see Page 10, Line 10 of the specification). Reference number 260 was previously designated to an "inner side piece" (see Page 10, Line 2). Based on the drawings "outer side piece" should be designated as reference number 256 (see Fig. 4). Appropriate correction is required.
3. Other reference number inconsistencies may be present in the specification with respect to the drawings. Review and appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grimm (U.S. Pat. No. 2,284,815) in view of Montgomery (U.S. Pat. No. 6,708,874).

7. Grimm discloses a bottom plate (See Grimm Fig. 1, Reference Number 6), two side rectangular bodies (Fig. 2 generally) with embedded slots (See Fig. 1, 18,19), and a lower side plate (5,8,10) comprising an inner fixed (side) piece (10). Grimm does not disclose a handheld hole in the bottom plate. However, Montgomery discloses a bottom plate (see Montgomery Fig. 3, Reference Number 41) comprising a hand held hole (55). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Grimm so as to include a hand held hole. Motivation for the modification comes from Montgomery, which states that the hand held holes on the bottom plate serve to aid in grasping, lifting, removing and carrying the portable box.

8. Claims 2,3,7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grimm in view of Montgomery as applied to Claim 1 above, and further in view of Nemoto (U.S. Pat. No. 6,675,970).

9. Grimm does not disclose a bottom plate comprising two fixed pieces or the side rectangular bodies comprising outer, upper, inner, and lower side pieces and further

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comprising an insertions slot for the fixed pieces (between the inner side piece and the lower side piece) to be inserted into the rectangular bodies to fix them in position.

However, Nemoto discloses a bottom plate (see Nemoto Fig. 4, Reference Number 22d) with two fixed pieces (39c, 39d) and rectangular bodies (37a-37d) comprising outer, upper, inner, and lower side pieces and further comprising an insertion slot (38, 40c) for the fixed pieces to be inserted into the rectangular bodies (see Fig 5 generally). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Grimm so as to include the fixed pieces on the bottom plate, outer, upper, inner, and lower side pieces, and insertion slots on the rectangular bodies so that the fixed pieces could be inserted into the insertion slots to fix the rectangular bodies into position. Motivation for the modification comes from Nemoto, which states that the interaction between the fixed bodies and the insertion slots serves to support, fix, retain and protect the side rectangular bodies shape from external forces.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grimm in view of Montgomery as applied to Claim 1 above, and further in view of Lopez (U.S. Pat. No. 4,511,079).

11. Grimm discloses a lower side plate (see Grimm Fig. 1, Reference Numbers 5,8,10) comprising an outer side piece (5), an upper side piece (8), and an inner side piece (10) connected in sequence. Grimm does not disclose an opening hole located in the upper side piece. However, Lopez discloses a lower side plate (see Lopez Fig. 1, Reference Numbers 6,10,12) where the upper side piece (10) includes an opening hole (17). Therefore, it would have been obvious to one of ordinary skill in the art to modify

Grimm to include an opening hole in the upper side piece of the lower side plate for the purpose of facilitating opening of the box to reveal a lower rectangular body.

12. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grimm in view of Montgomery as applied to Claim 1 above, and further in view of Starr (U.S. Pat. No. 4,522,303).

13. Neither Grimm nor Montgomery disclose that the box is disposed in a packaging carton of a notebook. However, Starr discloses a container for receiving various packaged computer peripherals. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention to include it in a packaged carton of a notebook. Motivation for the modification comes from the idea that consumers demand that their computer purchases include all the necessary equipment so that they may immediately use their notebook computer. It would be inconvenient to require consumers to separately purchase the disc drive, mouse, power supply, etc... from their purchase of the notebook computer. Additionally, including the accessory box in the packaged carton of a notebook reduces packing and shipping costs as well as saves storage space. Finally, placing the packaged accessories in an additional packaged carton protects the accessories from damage and stress during shipping, storing, and handling of the packaged carton.

14. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grimm in view of Montgomery as applied to Claim 1 above, and further in view of Kataoka (U.S. Pat. No. 5,899,336).

15. Neither Grimm nor Montgomery disclose that the material of the box is a paper plate having a buffer structure. However, Kataoka discloses a box made of a sheet of corrugated paper, essentially a paper plate with a buffer structure (and within the common meaning of the term corrugated paper). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention to have the box made out of a paper plate with a buffer structure. Motivation comes from Kataoka, which states that the corrugated paper plate protects electronic products and is cost effective in relation to comparable alternatives.

16. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grimm in view of Montgomery and Nemoto as applied to Claims 2,3,7, and 8 above, and further in view of Lopez.

17. Grimm does not disclose an opening hole located in the upper side piece. However, Lopez discloses a lower side plate (see Lopez Fig. 1, Reference Numbers 6,10,12) where the upper side piece (10) includes an opening hole (17). Therefore, it would have been obvious to one of ordinary skill in the art to modify Grimm to include an opening hole in the upper side piece of the lower side plate for the purpose of facilitating opening of the box to reveal a lower rectangular body.

18. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grimm in view of Montgomery and Nemoto as applied to Claims 2,3,7, and 8 above, and further in view of Starr.

19. Starr is applied in this rejection for the same reasons as stated in the rejection of Claim 5 mentioned above.

20. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grimm in view of Montgomery and Nemoto as applied to Claims 2,3,7, and 8 above, and further in view of Kataoka.

21. Kataoka is applied in this rejection for the same reasons as stated in the rejection of Claim 6 mentioned above. It would also have been obvious to one having ordinary skill in the art at the time the invention was made to have selected a corrugated paper as the preferred material selection, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

22. Claims 13 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grimm in view of Deline (U.S. Pat. No. 3,018,940)

23. Grimm discloses a bottom plate (see Grimm Fig. 1, Reference Number 6), two side rectangular bodies (12,14,16 and 13,15,17), embedded slots (18,19), a lower side plate (5,8,10) comprising an inner side piece (10), an upper side plate (7,9,11) comprising an inner side piece (11) and an outer side piece (7). Grimm does not disclose an upper side plate with an outer side piece comprising a hand taken hole. However, Deline discloses an upper side plate (See Deline Fig. 1, Reference Number 15) with an outer side piece (12) comprising a hand taken hole (17). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the box to include a hand taken hole for the purposes of carrying it. Motivation is provided by the fact that hand held holes enable users to conveniently lift, remove and carry the portable box to a new desired location.

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24. As to Claim 17, Grimm discloses the lower side plate (5,8,10) comprising an outer side piece (5), an upper side piece (8), and an inner side piece (10).

25. As to Claim 19, Grimm discloses the upper side plate (7,9,11) comprises an upper side piece (9), inner side piece (11), and an outer side piece (11).

26. Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable because it would have been obvious to one of ordinary skill in the art to modify the inner side piece of the upper and lower side plate to include two lower embedded slots to embed into the embedded slot of each of the side rectangular bodies. Motivation for this modification comes from the fact that embedded slots provide additional support to the partitions that make up the various compartments of the accessory box. The slots also facilitate alignment of the inner side piece with the formed rectangular bodies. Additionally, the use of the slots is advisable for economy of material so that the inner side piece does not have to completely extend to the bottom plate. Barker (U.S. Pat. No. 2,271,243) provides extrinsic evidence that including embedded slots in a foldable blank for the above reasons is obvious to one of ordinary skill in the art.

27. Claims 14,15,and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grimm in view of Deline as applied to Claims 13 and 17-20 above, and further in view of Nemoto.

28. Grimm and Deline do not disclose that the rectangular bodies of the accessory box comprise an outer, upper, inner and lower side pieces, an insertion slot between the inner side piece and lower side piece, or a bottom plate comprising two fixed pieces to fix the side rectangular bodies. However, Nemoto discloses a bottom plate (see

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Nemoto Fig. 4, Reference Number 22d) with two fixed pieces (39c, 39d) and rectangular bodies (37a-37d) comprising outer, upper, inner, and lower side pieces and further comprising an insertion slot (38, 40c) for the fixed pieces to be inserted into the rectangular bodies (see Fig 5 generally). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Grimm and Deline so as to include the fixed pieces on the bottom plate, outer, upper, inner, and lower side pieces, and insertion slots on the rectangular bodies so that the fixed pieces could be inserted into the insertion slots to fix the rectangular bodies into position. Motivation for the modification comes from Nemoto, which states that the interaction between the fixed bodies and the insertion slots serves to support, fix, retain and protect the side rectangular bodies shape from external forces.

Conclusion

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. Pollicoff whose telephone number is (571)272-7818. The examiner can normally be reached on M-F: 7:30A.M.-4:00P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SBP



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